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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,501	08/01/2001	Hubert Helaine	Q65593	3234
23373 7590 07/16/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/918,501

Applicant(s)

HELAINÉ ET AL.

Examiner

Marcos L. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5-2-07 have been fully considered but they are not persuasive.
2. Regarding applicant argument directed to Buhrmann, those limitations are taught Shah not Buhrmann.
3. As to the argument directed to Shah, applicant admits that Shah have a correspondence memory between base stations (see page 5), but applicant states that because the base station are "public" they are fundamentally different, since the public base station cover a wide area and serve the general public. However, applicant fails to mention how this affects the feature code. For example a service code that is activated by using *57, how it is affected by changing the covering area? Covering a wide area would affect transmission power, but have absolutely nothing to do with features codes. Equally, serving more than one person does not affect in anyway a service or feature code. Secondly, the comment that base stations are configured to extremely wide coverage area is misplaced, base station comes in all flavors with low, medium or high power, for example base station with low power are well known in the art as micro cell or Pico cell. And as previously stated applicant arguments have nothing to do with features codes. Applicant arguments are moot.
4. Shah discloses using a correspondence memory, so the user does not have to learn the service codes when he moves from one base station to another type of base station (see abstract). So the combination of Shah and Burhmann will create a mobile

station that will learn if there is a different feature code in the base station (public or private) and will use the memory to automatically change the features codes in a transparent manner to the user, so the user can keep using the accustomed code and does not need to learn if the codes change for a particular base station (see Shah abstract).

5. Buhrmann and Shah disclose connecting between first and second network (see col. 3, lines 29-39 in Buhrmann and col. 3, lines 20-24 in Shah).

6. Regarding applicant argument that there is no suggestion to modify the references, please see previous official action were show the motivation in Shah col. 1, lines 5-10; also see col. 3, lines 1-12.

7. For the rest of the arguments, they fall together for the same reasons as shown above. The current rejection in record stand.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-2, 9 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Buhrmann US 6,035,193 in view Shah US 6,029,065.

As to claims 1, 15 and 16, Buhrmann discloses an automatic network services management method comprising: connecting a communication terminal of a first network is connected to a private base (see col. 1, lines 6-9), connecting said private base is connected to a second network (see fig. 1; col. 3, lines 29-39), and a memory establishing service codes of said first network (see col. 7, lines 57 –col. 8, line 10). Buhrmann does not specifically disclose the memory establishing correspondence. In an analogous art, Shah discloses the memory establishing correspondence (see col. 3, lines 35-40; col. 7, lines 4-17). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to combine the Shah and Buhrmann teachings for the simple purpose of compatibility between networks (see Shah col. 1, lines 5-10).

As to claim 2, Shah discloses the method of using a correspondence memory in the communication terminal (see col. 4, lines 1-9)

As to claim 9, Shah discloses the method wherein said correspondence memory is updated between a call of between the terminal and the first network (see col. 10, lines 31-35).

As to claims 12 and 13, Shah discloses the method wherein said first network is a mobile telephone network and second network is a terrestrial telephone network (see col. 1, lines 14-17).

As to claim 14, Shah discloses the method wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base (see col. 6, lines 40-44).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and further in view of Sipilä (EP 0748136A1).

As to claim 3, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is in said private base. In an analogous art, Sipilä discloses the method wherein said correspondence memory is in said private base (see col. 2, lines 3-11; col. 9, lines 27-52), therefore allowing the updated features be used in legacy terminal. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for the simple purpose of compatibility with old terminals.

5. Claims 4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä as applied to claim 3 above, and further in view of Kasmperschroer (U.S. Patent US006434399B1).

As to claim 4, Shah the method wherein: a request corresponding to a service is composed from said communication terminal (see col. 9, lines 1-3), said request is sent from said communication terminal and received at said private base (see col. 9, lines 13-15). Shah does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network, or wherein said request is updated in said private base as a function of said correspondence memory. Sipilä discloses wherein said request is updated in said

private base as a function of said correspondence memory (see col. 9, line 26 - col. 10, line 3). Sipilä does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network.

Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method to ensure compatibility in the connection.

As to claims 6 and 7, Kasmperschroer disclose processing of said request by an operator managing said services of said second network (see col. 7, lines 6-24). Shah discloses the method wherein an acknowledgement is received at said communication terminal or private base (see col. 11, lines 13-22). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of confirms the delivery of data.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä and further in view of Kasmperschroer as applied to claims 4 and 6-7 above, and further in view of Vanden Heuvel (U.S. Patent US005924014A).

As to claim 5, Sipilä discloses the method wherein, if said correspondence data contains no match to said request sent by said communication terminal send an error message (see col. 9, lines 13-17). Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second

network (see col. 7, lines 6-24). Sipilä and Kasmperschroer do not specifically disclose transmitting without changing the format. Vanden Heuvel discloses transmitting without changing the format (see col. 10, lines 16-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the modified Sipilä and Kasmperschroer method for the simple purpose of compatibility.

7. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann in view of Shah and Kasmperschroer.

As to claim 8, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is updated during a call between said private base and an operator. In an analogous art, Kasmperschroer the method wherein said correspondence memory is updated during a call between said private base and an operator (see col. 7, lines 6-24)., thereby allowing to updated the services between the system. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for enhanced compatibility between systems.

As to claims 9, Shah discloses the method wherein said correspondence memory is updated automatically (see col. 6, lines 40-45).

As to claim 11, Shah discloses the method wherein said updating is triggered by a user (see col. 10, lines 46-48).

As to claim 10, Shah discloses the method wherein said correspondence memory is updated periodically. However, OFFICIAL NOTICE IS TAKEN THAT the technique of updating memory periodically it is a common and well-known technique.

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Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple reason of refresh the memory cycle and preserve the data.

8. Examiner's note: Examiner has cited particular sections in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any response to this Office Action should be mailed to:

U.S. Patent and Trademark Office
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcos L Torres
Examiner
Art Unit 2617


mlt


GEORGE ENG
SUPERVISORY PATENT EXAMINER